



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,410	02/14/2006	Domonique Teyssie	285619US0PCT	7551
22850	7590	03/10/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZEMEL, IRINA SOPHIA	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			03/10/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/568,410	Applicant(s) TEYSSIE ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Invention Group I, claims 1-3,6-10 and 14 in the reply filed on 1-2-2009 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner to examine all claims together. This is not found persuasive because a serious burden for searching all group together is clearly exists since the searches for the invention groups are not co-extensive, and search for invention Groups II and II is not required for the elected Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6-10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the polymer of isobutene can be characterized as crosslinked, when it has the crosslinkable groups only at the chain ends and less than 50 % of the chains even have it at both ends (based on the claims 1.4 functionality). By reacting with a crosslinking agent, the resulting polymer is either chaing couled (chain extended) or, at best, represents a star polymer of the crosslinking agent is multifunctional agent

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,019,074 to Nakamura et al., (hereinafter "Nakamura").

Nakamura discloses a composition comprising a mixture of interpenetrating polymers with a first phase of a crosslinked isobutene polymer and with a second phase of a reinforcing polymer which comprises vinylaromatic units (styrene based copolymers). The first phase comprises the reaction product of an organic polymer with functional groups in the molecule and of a crosslinking agent. Among suitable organic polymers isobutene polymer is expressly disclosed in column 2, lines 49-50, for example. The functional groups of the organic polymers are disclosed as hydrolizable silicone group. (column 3, lines 52 et seq.). The crosslinking agents disclosed in the reference (silane coupling agents) are being complementary to that of the functional groups of the isobutene polymer. The organic polymer has a number-average molecular weight of from 500 to 50 000 prior to the crosslinking process. (Column 5, lines 52-61).

The reference further expressly discloses that the functional groups are preferably contained at the chain end of the organic polymers and preferably at both

Art Unit: 1796

ends (which reads on the claimed average of functional groups per molecule or organic polymer).

It is further noted that the claimed first phase is a product-by-process, resulting from reacting a functional polyisobutene with the crosslinking agent. It is noted that this product is substantially identical to a product of reacting a silane hydrolizable crosslinking agent with functionalized polyisobutane or functionalizing polyisobutene with hydrolizable end groups followed by its hydrolization. The reference expressly discloses methods of adding hydrolizable silane groups to unsaturated chain ends (see column 4, lines 61-64), reacting the polymer with bi-functional monomers containing silane groups. Reacting functional polymers with silane coupling/crosslinking agents will result in the same polymers as hydrolizing silane functional polymers.

The reference does not disclose specific use of the composition as "Molding" composition, however, this limitation in the claims is a mere intended use of the composition. Thus, this limitation is given weight only to the extent that the composition disclosed in the reference is capable of being used such. The disclosed composition is inherently capable for the claimed use because the claimed composition is believed to be substantially identical to the composition disclosed in the reference. Therefore, the preamble limitation is anticipated by the reference. The burden is shifted to the applicant to provide convincing factual evidence to the contrary. It is further noted that the exemplified "molding" of the composition according to the instant specification comprises casting molding of the composition, or curing the composition between two

Art Unit: 1796

glass sheets, which is similar to the curing the composition disclosed in the reference between two substrates as illustrated in the examples of the reference.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 6-11 and 14 filed by the applicants in their response dated 4/16-2008 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/

Irina S. Zemel

Application/Control Number: 10/568,410

Page 6

Art Unit: 1796

Primary Examiner, Art Unit 1796

Primary Examiner
Art Unit 1796

ISZ